

REMARKS

Claims 16 to 38 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 16 to 38 were rejected under 35 U.S.C § 103(a) as unpatentable over EP 1,111,753 to Koji et al., (“Koji”) in view of U.S. Publication No. 2003/107351 to Tanguchi et al., (“Tanguchi”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 16 relates to an electrical device for controlling a generator in an electrical system of a motor vehicle. It provides that the controller provides a **first area of operation** ... in which a voltage control is performed to regulate the generator voltage, to the **exclusion of performing a torque control to regulate a braking torque exerted by the generator**, and at least one **second area of operation** based ... in which the **torque control** is performed, to the **exclusion of performing the voltage control**, the **controller transitioning**

from the first area to the at least one second area when the generator voltage goes beyond one of a first upper threshold value and a first lower threshold value, the first upper threshold value and the first lower threshold value being defined by a boundary of the first area.

Accordingly, claim 16 provides for a **first area of operation** in which **voltage control** is performed to the **exclusion of performing a torque control**, and a **second area of operation** in which **torque control** is performed to the **exclusion of performing the voltage control**.

It is respectfully submitted that neither Koji nor Tanguchi discloses (or suggests) at least the above identified features of claim 16. Accordingly, the asserted combination of Koji and Tanguchi is likewise deficient, even in view of the knowledge of one of ordinary skill in the art.

The Office Action concedes that the Koji reference “fails to disclose a controller configured to control a torque of the generator.” (*Office Action*, page 4). Moreover, even if Tanguchi did discuss controlling the torque of a generator, there is absolutely no discussion about performing it at the **exclusion of performing voltage control in the second area of operation**, as in claim 16.

Accordingly, Taniguchi does not cure the deficiencies of the Koji reference. Indeed, any review of the Koji or Tanguchi references, whether taken alone or in combination, makes clear that it does not disclose different areas of operation, in which in one voltage control is performed to the exclusion of performing a torque control, and which in the other torque control is performed to the exclusion of performing the voltage control, and in which the voltage control is done with respect to a first upper threshold and a first lower threshold value, as provided for in the context of the claimed subject matter.

To the extent the Office Action’s rejection may be based on the belief that the suggested modification of the Koji reference is a design choice, it is respectfully submitted that reliance on such a rationale to support an obviousness rejection, without any suggestion or motivation in the prior art to modify the prior art teaching to include a particular claim feature, is inappropriate where the significance of the particular claim features has been demonstrated – as here.

In this regard, the specification of the present application specifically discloses that the “control concept according to the present invention makes it possible for [the] coordinating unit to adjust extreme conditions, such as voltage control at great torque

changes, torque control at strong voltage fluctuations, as well as any intermediate conditions.” (*Substitute Specification*, page 2 line 31, to page 3 line 3).

Accordingly, Applicants have recognized, for example, that providing a first area of operation based on the value of the generator voltage to the exclusion of performing a torque control to regulate a braking torque exerted by the generator, and at least one second area of operation in which the torque control is performed to the exclusion of performing the voltage control, as provided in the context of the claimed subject matter, are significant features that provide solutions to problems which Applicants have recognized arise in the prior art systems. Thus, contrary to the Office’s assertions, these features are not a mere engineering design choice, but are rather provided as a significant feature of allowable subject matter.

Additionally, it is respectfully submitted that the Office has not provided any reference that discloses or suggests an electrical device according to the features of claim 16. Accordingly, any such modification of the Koji reference to remedy the conceded deficiency, necessarily relies on improper hindsight reasoning based on Applicants’ disclosure, which cannot support an obviousness rejection.

As further regards the obviousness rejection of the claim 16, it is respectfully submitted that not even a *prima facie* case has been made in the present case for obviousness, since the Office Action has not made any findings, such as, for example, regarding what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (*See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art,” and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone,” as here. (*See In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art,” the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Action.

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In view of all the foregoing, claim 16, is allowable, as are its dependent claims 17 to 24, 31 to 34, 37, and 38.

Claim 25 includes subject matter like that of claim 16 and it is therefore allowable, as are its dependent claims 26 to 30, 35, and 36.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Withdrawal of the obviousness rejections is therefore respectfully requested.

In sum, claims 16 to 38 are allowable.

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CONCLUSION

In view of the foregoing, it is respectfully submitted that all of presently pending claims 16 to 38 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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